

### **Remarks**

No claims have been added or amended by this paper. Claims 1-21 are pending.

Claims 1-7, 13, 14, 19, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Boyles in view of Rangan. The Applicant submits that independent claims 1 and 19 are patentable for the reasons set forth below.

Independent claim 1 recites “a programming source for generating a programming signal for programming the transmitter for prohibiting operation of the remotely controlled component during at least one programmable period.” The Examiner admits that Boyles fails to teach this limitation, but relies upon Rangan to make up for this deficiency of Boyles.

In the Examiner’s Response to Arguments, the Examiner states “that the fact that Rangan teaches a time delay suggest to one skilled in the art that the time delay had to be programmed (i.e. programmable) by a software source at some point of time.”

Rangan merely teaches a time delay switch 245 to limit operation based upon a predefined time interval that begins counting with actuation of buttons 130, 135 and 140. There is no express teaching in Rangan, and none is pointed by out by the Examiner, that the predetermined period of time can be changed after the transmitter is initially programmed. The Applicant is clearly claiming “programmable” in the context of a transmitter that may be programmed after the transmitter is initially programmed.

The Examiner’s rejection is inconsistent with the obviousness standards set forth in MPEP § 2143.01, as recited below:

**Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so** found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, **knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested** to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also > In re Lee, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); < In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

2143.01 The mere fact that references can be combined or modified does **not render the resultant combination obvious unless the prior art also suggests** the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)

(Emphasis added)

The prior art, i.e., Boyles and Rangan, when considered in light of one having ordinary skill in the art, must provide at least some suggestion, motivation, or incentive to modify the teachings of Rangan so that the time delay switch 245 can be programmed after its initial programming. The Examiner has failed to meet this burden. The Examiner's reliance on one skilled in the art is insufficient as neither Boyles, Rangan, or any other cited reference identifies the problem of programming the time periods of operation.

The Examiner is merely engaging in improper hindsight reasoning derived from the Applicant's application. The following Federal Circuit ruling clarifies the Examiner's actions:

**Rarely, however, will the skill in the art component operate to supply missing knowledge** or prior art to reach an obviousness judgement. See W.L. Gore & Assocs., Inc. v.

Garlock, Inc... (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, where no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome where that which only the inventor taught is used against its teacher.’).”

(Al Site Corp v. VSI International, Inc. 174 F.3d 1308 (Fed. Circ. 1999), emphasis added)

The Examiner fails to point out any teaching in the prior art or from one skilled in the art that is sufficient to show the desirability of programming the time periods of operation for the transmitter. The Examiner supplies this missing knowledge by imbuing one of ordinary skill in the art with the knowledge of the Applicant’s invention. The insidious effects of this hindsight reasoning can only be remedied by the Examiner providing some teaching in the prior art of programming the periods of operation for the transmitter. In the absence of such a teaching, the Applicant respectfully submits independent claim 1 and dependent claims 2-7, 13, and 14 are patentable over Boyles and Rangan.

Claim 19 recites that the transmitter is programmed by a signal generated remotely “from the programmable transmitter for programming the transmitter to prohibit operation of the vehicle by the security system during at least one programmable period.” The time delay switch 245 of Rangan does not receive any programming signals, let alone a programming signal originating from a source remotely located from the transmitter. Rangan fails to provide any suggestion of receiving programming signals from a source remotely located from the transmitter. Consequently, independent claim 19 and claim 20 are separately patentable over Boyles and Rangan.

Claims 8-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyles, Rangan, and Asano. Claims 8-11 depend from independent claim 1 that is patentable for the reasons stated above. To reject claims 8-11 the Examiner relies upon Asano to teach the use of a computer as programming source. Applicants submit this reliance upon Asano fails to make up for the above-identified deficiencies of Boyles and Rangan with respect to

independent claim 1. Further, dependent claims 8-11 are patentable because they specify that the programming signal and separately that it is transmitted by a cable or an RF link. These are the precise concepts that are completely omitted from the cited prior art.

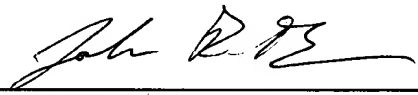
Claims 12, 15-18, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Boyles, Rangan, and Elsmann. This rejection includes independent claims 15 and 21 (claims 16-18 depend from claim 15), and dependent claim 12 (which depends from independent claim 1). Each of these claims include limitations directed towards prohibiting operation during specific periods of a time of day. Independent claim 15 and dependent claim 12 relate to programming a transmitter. Independent claim 21 relates to programming a receiver on a vehicle. Programming prohibited operation time periods is completely missing from the cited references.

The Examiner admits that Rangan fails to teach that the time delay switch 245 can be programmed for specific periods of a time of day and relies upon Elsmann to make up for this deficiency. Elsmann merely teaches that a controller on the vehicle is programmed to limit vehicle operation during specific periods of a time of day. Elsmann fails to provide any suggestion, motivation, or incentive to teach that a transmitter could be similarly programmed. Elsmann fails to make up for the above-identified deficiencies of Rangan with respect to programming the transmitter as Elsmann has nothing to do with transmitters. Claims 12 and 15-18 are, therefore, patentable over Boyles, Rangan, and Elsmann.

Independent claim 21 relates to programming the receiver on the vehicle to prohibit remote operation of the vehicle security system by a transmitter during specific periods of a time of day. Elsmann fails to provide any teaching that the vehicle has a remotely controlled vehicle security system that operates based on signals received from a programmable transmitter. Elsmann cannot teach that a receiver used in such a system can be programmed to prohibit operation during specific periods of a time of day. Claims 12 and 15-18 are, therefore, patentable over Boyles, Rangan, and Elsmann.

Applicants respectfully requests reconsideration of the rejections in light of the above amendments and remarks. The Examiner is invited to call the under signed attorney if it would further prosecution of this case. The Examiner is respectfully requested to pass this case to issue.

Respectfully submitted,  
**BARRY L. CAREN**

By   
John R. Buser  
Reg. No. 51,517  
Attorney/Agent for Applicant

Date: 4-18-04

**BROOKS KUSHMAN P.C.**  
1000 Town Center, 22nd Floor  
Southfield, MI 48075-1238  
Phone: 248-358-4400  
Fax: 248-358-3351